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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mitsuaki Oshima

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3685

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,904	Applicant(s) OSHIMA ET AL.	
	Examiner CHARLES C. AGWUMEZIE	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-42 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/26/04; 01/11/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2009 has been entered.

Acknowledgments

2. Applicants' amendment filed on September 16, 2009 is acknowledged. Accordingly claims 39-44 remain pending.

Submitted New Drawing Fig. 3A

3. The submitted new drawing fig. 3A is unacceptable because it introduces new matter which was not disclosed in the original drawings. The new drawing submitted on March 10, 2009 indicates an overlap between the first recording area and the second recording area which was not disclosed in the originally filed specification nor on the original filed drawing. Accordingly it is Examiner's position that that the new submitted drawing introduces a new matter not supported by the original filings. Examiner's initiated interview with Applicant's representative on June 15, 2009 failed to disclose information sufficient to support the modification submitted via the new drawing of fig.

3A. Accordingly the new fig. 3A is hereby rejected and has been placed on file. This decision is hereby made final.

Response to Arguments

4. Applicant's arguments filed September 16, 2009 have been fully considered but they are not persuasive.

5. With respect to the submitted new fig. 3A, Applicant argues that new fig. 3A is supported by applicants' original Fig. 3A to 3G and fig. 5A, especially by original figs. 3E and 5A. That New Fig. 3A is also supported by page 5, lines 22-26; page 7, lines 10; and lines 20-24 in the applicants' specification.

In response, Examiner respectfully disagrees with Applicants' characterization of the specification and originally filed Figs. 3A to 3G and fig. 5A, especially by original figs. 3E and 5A. None of the information contained in Figs. 3A to 3G and fig. 5A, especially by original figs. 3E and 5A explains the overlap between the first recording area and the second recording area as contained in the new Fig. 3A. The overlapping was not disclosed in the originally filed specification nor on the original filed drawings. Examiner have thoroughly examined Applicants' cited portions of the specification and found no such support for the overlap between the first recording area and the second recording area as shown in the new submitted Fig. 3A. Accordingly the newly submitted Fig. 3A introduces a new matter not originally disclosed in the originally filed specification nor the in the originally filed drawings. Accordingly the decision to place the new Fig. 3A on file is made final.

6. With respect to **claims 39 and 41**, Applicant argues that Applicants' invention as recited in independent claims 39 and 41, includes an "auxiliary information presence indicator" having two limitation which are neither disclosed nor suggested by the cited prior art, namely (i) the auxiliary information presence indicator is in the control data area in the optical disk; and (ii) the auxiliary information presence indicator indicates whether the auxiliary information is present or not in the second recording area.

In response, Examiner respectfully disagrees and submits that Sekiguchi's auxiliary information presence indicator does comprise the claimed limitation. With respect to (i) above Sekiguchi teaches that a plurality of auxiliary signals and an information signal are consecutively outputted and recorded onto a track of the optical disk (see abstract). With respect to (ii) above, Sekiguchi further teaches detecting the amplitude of the auxiliary signals (col. 5, lines 40-55). Accordingly Sekiguchi does teach or suggest the two claimed limitations.

7. Applicant further argues with respect to claims 39 and 41, that the auxiliary signal amplitude detector 19 in Sekiguchi is a unit in the recording apparatus not in the optical disk, which is completely different from the present applicants' (i) auxiliary information presence indicator which is in the control data area in the optical disk.

In response, Examiner respectfully disagrees and submits that Sekiguchi clearly teaches that a plurality of auxiliary signals and an information signal are consecutively outputted and recorded onto a track of the optical disk (see abstract). The fact that a hardware unit is incorporated into the apparatus does not take out the fact that the

auxiliary information presence indicator is outputted and recorded on the track of the optical disk.

8. Applicants' further argues that the auxiliary signal amplitude detector 19 in Sekiguchi detects the amplitude of the auxiliary signals. That it cannot indicate whether the auxiliary signals are present or not without directly detecting the auxiliary signals. That Applicants' system (ii) indicates that auxiliary information is present or not without detecting the auxiliary information itself.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "without detecting the auxiliary information itself") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is Examiner's position that both the auxiliary presence indicator as claimed and auxiliary signal amplitude detector of Sekiguchi are read before determination of the presence of the auxiliary information can be made contrary to the Applicants' argument and both determines presence of auxiliary information or signal.

Terminal Disclaimer

9. The terminal disclaimer filed on July 10, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of

U.S Patent No. 6,081,785 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 39 and 41**, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for “overlapping the most radially inward portion of said first recording area”. There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required.

Applicant's amendments/arguments filed September 16, 2009 have been considered but are deemed without merit since the applicant argues an invention lacking support in the specification and based entirely on new matter.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 39-42 and 44**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi et al (hereinafter "Sekiguchi") U.S. Patent No. 5,253,241 in view of Fujiwara et al (hereinafter "Fujiwara") U.S. Patent No. 5,251,011.

14. As per **claims 39 and 41**, Sekiguchi discloses an optical disk comprising:

a first recording area for recording main data (see fig. 6, which discloses recording area 1; see col. 5, lines 15-40); the first recording area comprising:

a second recording area overlapping the most radially inward portion of said first recording area and having auxiliary information including disk identification information unique to said optical disk recorded therein, (see fig. 6, which discloses recording area 2; see col. 5, lines 15-40);

wherein said auxiliary information is recorded as circumferentially arranged multiple stripe patterns, each stripe of which extends along a radius of the disk (see abstract, which discloses that "a plurality of auxiliary signals and an information signal are consecutively outputted and recorded onto a track of the optical disk")

a control data area in the first recorded area (see fig. 2; which discloses recording control signal; col. 5, lines 40-55); comprising

an auxiliary information presence indicator indicating whether said auxiliary information is present or not in the second recording area (see fig. 7; which discloses auxiliary signal amplitude detector; col. 5, lines 40-55, which discloses detecting the amplitude of the auxiliary signals),

wherein said stripe patterns have a lower reflectivity than an average reflectivity of an area between one stripe pattern and another stripe pattern.

15. What Sekiguchi did not explicitly teach is:

wherein said stripe patterns have a lower reflectivity than an average reflectivity of an area between one stripe pattern and another stripe pattern. Sekiguchi however discloses the concept of reading an information signal on the basis of the resultant reflected beam from the optical reproduction disk

16. Fujiwara discloses:

wherein said stripe patterns have a lower reflectivity than an average reflectivity of an area between one stripe pattern and another stripe pattern (col. 2, lines 30-40, which discloses that the surface has a high contrast reflectance which varies from place to place...).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Sekiguchi and incorporate the method, wherein said stripe patterns have a lower reflectivity than an average reflectivity of an area between one stripe pattern and another stripe pattern in view of the teachings of Fujiwara in order to ensure proper recording on the optical disk.

17. As per **claims 40**, Sekiguchi further discloses the optical disk, wherein said second recording area is recorded at a lower frequency than in an area of said first recording area other than said second recording area (col. 4, lines 20-45, which discloses having different frequency components from one another).

18. As per **claim 42**, Sekiguchi further discloses the reproducing method, wherein the detecting the signal of said second recording area comprises:

separating with a low pass filter said reproducing signal of said second recording area and a reproducing signal of an area of said first recording area other than said second recording area (col. 5, lines 55-60; col. 6, lines 2-20)

19. As per **claim 44**, Sekiguchi further discloses the optical disk wherein the auxiliary information is recorded with a modulation different from a modulation of the main data (see fig. 15; col. 4, lines 20-45, which discloses switching between ...auxiliary signal and ... information signal DATA1 ; col. 7, lines 10-25, which discloses the process of varying the recording wavelength on the medium in relation to another wavelength).

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Calvin Hewitt** can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
December 2, 2009